Supreme Court, U.S.
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No. 05-

IN THE
Supreme Court of the United States

Memorex Products Inc. (formerly doing business as Memtec Products, Inc.), Pretec Electronics Corporation, and Ritek Corporation,

Petitioners,

v.

SanDisk Corporation,

Respondent.

On Petition for Writ of Certiorari To The United States Court Of Appeals For The Federal Circuit

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PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

Consistent with the this Court's decision in *Markman v. Westview Instruments*, 517 U.S. 370 (1996), is it appropriate for appellate courts to accord any deference to any aspect of trial court claim construction rulings? If so, on what aspects, in what circumstances, and to what extent?

PARTIES TO THE PROCEEDING AND CORPORATE DISCLOSURE STATEMENT

The parties to the proceeding below were:

Memorex Products, Inc. (formerly doing business as Memtec Products, Inc.) ("Memorex"),

Pretec Electronics Corporation ("Pretec"),

Power Quotient International Co., Ltd., and

Ritek Corporation ("Ritek").

All parent corporations and publicly held companies that own 10 percent or more of the stock of the Petitioners are:

For Memorex:	Hanny Holdings, Inc.
For Pretec:	C-One Technology Corporation
For Ritek:	None

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Memorex, Pretec, and Ritek hereby petition for a writ of certiorari to review the decision of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The Federal Circuit's decision vacating and remanding to the District Court for further proceedings (Appendix to Petition ("App.") 1a-26a) is reported at 415 F.3d 1278. The District Court's relevant substantive opinion reviewed by the Federal Circuit is unreported (App. 27a-59a).

JURISDICTION

The Federal Circuit entered its opinion and judgment on July 8, 2005. This Court has jurisdiction under 28 U.S.C. § 1254(1).

REGULATIONS INVOLVED

This petition involves Federal Rule of Civil Procedure 52(a):

> Rule 52. Findings by the Court; Judgment on Partial Findings
>
> (a) Effect.
>
> In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon, and judgment

shall be entered pursuant to Rule 58; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Requests for findings are not necessary for purposes of review. Findings of fact, whether based on oral or documentary evidence, shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. The findings of a master, to the extent that the court adopts them, shall be considered as the findings of the court. It will be sufficient if the findings of fact and conclusions of law are stated orally and recorded in open court following the close of the evidence or appear in an opinion or memorandum of decision filed by the court. Findings of fact and conclusions of law are unnecessary on decisions of motions under Rule 12 or 56 or any other motion except as provided in subdivision (c) of this rule.

STATEMENT OF THE CASE

This case involves alleged patent infringement, and the basis for federal jurisdiction in the District Court was 28 U.S.C. § 1338(a). Respondent SanDisk Corporation ("SanDisk") alleged infringement of its U.S. Patent No. 5,602,987 ("the '987 Patent") by Petitioners Memorex, Pretec, and Ritek. *See SanDisk Corporation v. Memorex Products, Inc.*, 415 F.3d 1278, 1280 (Fed. Cir. July 8, 2005) (App. 1a-2a).

Before filing its complaint against Petitioners, SanDisk successfully asserted the '987 Patent against Lexar Media Inc. ("Lexar"). *See id.* at 1282 (App. 6a-7a). In its case against Lexar, District Judge Charles Breyer interpreted the claims of the patent. *See id.* (App. 6a). The claim step of interest is "partitioning the memory cells within the individual sectors into at least a user data portion and an overhead portion." (App. 40a). In interpreting the claims, Judge Breyer ruled that this meant, "*Each* non-volatile memory sector must have at least one user data portion *and* one overhead data portion, but is not limited to only one data user portion and only one overhead data portion." (App. 6a (first emphasis added)). Based in part on this interpretation, Judge Breyer granted SanDisk judgment of infringement against Lexar. *See* 415 F.3d at 1282 (App. 7a).

SanDisk then asserted the '987 Patent against Petitioners. *See id.* at 1283 (App. 7a) SanDisk sought a preliminary injunction based on Judge Breyer's interpretation of the claims. *See id.* (App. 7a). Ritek argued that it did not infringe under Judge Breyer's claim interpretation because each non-volatile memory sector in its products did not have at least one user data portion and one overhead data portion. District Judge Vaughn Walker agreed. *See id.* (App. 7a). Judge Walker performed his own initial inquiry into the meaning of the claims and considered the prosecution history. In prosecuting the '987 Patent, SanDisk had stated, "Stored in *each* sector is a sectors [sic] worth of user data and some

overhead information (a header) about the sector and/or about the user data stored in the sector." (App. 48a (emphasis added)). Relying on this statement, Judge Walker concluded, as Judge Breyer had concluded, that each sector must have at least one user data portion and one overhead data portion. *See id.* (App. 7a). Consequently, SanDisk failed to show a likelihood of infringement by Ritek's products. *See id.* (App. 7a).

Ritek moved for summary judgment of non-infringement on the same basis that it had defeated SanDisk's preliminary injunction motion, arguing it could not infringe because each non-volatile memory sector in its products did not have at least one user data portion and one overhead data portion. (App. 36a). In deciding Ritek's summary judgment motin, Judge Walker performed a more extensive analysis of the claims than he had performed at the preliminary injunction stage. (App. 36a-51a). After performing his own independent analysis of the claim language, Judge Walker reached the same conclusion as Judge Breyer. Based on the evidence in the patent itself and in its prosecution history, including the statement from the prosecution history quoted above, Judge Walker held, "*Each* non-volatile memory sector contained within an array of non-volatile floating gate memory cells must include at least one user data portion and one overhead portion." (App. 40a (emphasis added)). Applying this interpretation, Judge Walker granted Ritek summary judgment of non-infringement and subsequently granted the same to the other Petitioners. *See* 415 F.3d at 1283 (App. 8a).